UNITED STATES PATENT AND TRADEMARK OFFICE

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EXAMINER
VIG, NARESH

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 03/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 May 2001*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-46* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-46* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 – 3 and 23 – 25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 1 – 3 and 23 – 25 only recites an abstract idea. The recited steps of merely making available to purchasers as a first variation having a first merchant-specific portion; making available to purchasers as a second; first-merchant

adds specific portion to produce the first variation; second merchant adds specific portion to the core portion to produce the second variation; deleting at least a part of the specific portion to produce a variation does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how make modify an existing document and convert it to a new document.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention produces allows modifications to an existing document (i.e., repeatable) used in creating a modified document (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claim 1 is deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1, 2, 4 – 23, 26, 27, 30, 31, 33, 34, 36, 37, 39 and 43 are re rejected under 35 U.S.C. 102(a) as being unpatentable over 1stUP by 1stUP.com hereinafter known as 1stUP.

Regarding claim 1, 1stUP teaches system and method for distributing variations of electronic data through multiple merchants to purchasers (users, subscribers, end users). 1stUP teaches:

publishing a core portion for a first merchant to make available to purchasers as a first variation having a first merchant-specific portion [page 10, 26 – 34];

publishing a second variation containing the core portion for a second merchant to make available to purchasers as a second variation having a second merchant-specific portion [page 10, 26 – 34], and

wherein the first merchant-specific portion differing from the second merchant-specific portion so that a purchaser's viewing or execution of the first variation evokes an association with the first merchant and a purchaser's viewing or execution of the second variation evokes an association with the second merchant.

Regarding claim 2, 1stUP teaches:

the first merchant adds the first-merchant specific portion to the core portion to produce the first variation [page 23], and

the second merchant adds the second-merchant specific portion to the core portion to produce the second variation [page 31].

Regarding claim 4, 1stUP teaches core portion includes a program executable by a computer device [page 6].

Regarding claim 5, 1stUP teaches core portion is a rendering application for rendering content, such that the rendering of content using the first variation evokes an association with the first merchant [page 28].

Regarding claim 6, 1stUP teaches core portion is a commerce application for purchasing goods or services, such that the purchase of goods or services using the first variation evokes an association with the first merchant (e.g. link to WJLA) [page 28].

Regarding claim 7, 1stUP teaches core portion is a commerce application for purchasing goods or services from the first merchant (field of use, e.g. link to merchant site like WJLA) [page 28].

Regarding claim 8, 1stUP teaches core portion is a commerce application for purchasing content (field of use, e.g. link to merchant site like WJLA) [page 28].

Regarding claim 9, 1stUP teaches first-merchant specific portion evokes an association with the first merchant by controlling an appearance of the program during execution [page 29].

Regarding claim 10, 1stUP teaches first-merchant specific portion evokes an association with the first merchant by providing a user interface for the program during execution that displays at least one image associated with the first merchant (design choice) [page 28].

Regarding claim 11, 1stUP teaches first-merchant specific portion evokes an association with the first merchant by controlling one or more functions of the program during execution (link to WJLA) [page 28].

Regarding claim 12, 1stUP teaches first-merchant specific portion evokes an association with the first merchant by providing added functionality to the program during execution, such that the added functionality relates to the first merchant (link to WJLA) [page 28].

Regarding claim 13, 1stUP teaches program is a browser application for retrieving content from sites in network (design choice to decide what technology to use) [page 11].

Regarding claim 14, 1stUP teaches first-merchant specific portion evokes an association with the first merchant by providing function controls in a user interface for the browser that facilitate the retrieval of content from only sites associated with the first merchant (link to WJLA) [page 28].

Regarding claim 15, 1stUP teaches first-merchant specific portion evokes an association with the first merchant by providing function controls in a user interface for the browser that facilitate the retrieval of specific content associated with the first merchant (link to WJLA) [page 28].

Regarding claim 16, 1stUP teaches first-merchant specific portion evokes an association with the first merchant by controlling an operation of the program during execution (link to WJLA) [page 28].

Regarding claim 17, 1stUP teaches first-merchant specific portion evokes an association with the first merchant by limiting or expanding the operation of the program during execution (design choice, link to WJLA) [page 28].

Regarding claim 18, 1stUP teaches program is a browser application for retrieving content from sites in network (provides internet access to users).

Regarding claim 19, 1stUP teaches first-merchant specific portion evokes an association with the first merchant by limiting the operation of the browser to the retrieval of content from only sites associated with the first merchant (link to WJLA) [page 28].

Regarding claim 20, 1stUP teaches first-merchant specific portion evokes an association with the first merchant by limiting the operation of the browser to the retrieval of specific content associated with the first merchant (link to WJLA) [page 28].

Regarding claim 21, 1stUP teaches first-merchant specific portion evokes an association with the first merchant by limiting operation of the browser application so that the browser application may retrieve content from designated sites only when the browser application is executing at a physical location defined by the first merchant (design choice, link to WJLA) [page 28].

Regarding claim 22, 1stUP teaches first-merchant specific portion evokes an association with the first merchant by facilitating cooperation between the program and another executable program associated with the first merchant (design choice, link to WJLA) [page 28].

Regarding claim 23, 1stUP teaches core portion is content such that rendering of the first variation evokes an association with the first merchant and rendering of the second variation evokes an association with the second merchant (link to plurality of merchants) [page 11].

Regarding claim 26, with respect to the recitation in claim 26 defining what kind of data is being stored on the database, this is considered to be non-functional

descriptive material that does not distinguish (define) over the applied prior art. Since

the instant claims are article claims and the type of data claimed is considered to be

non-functional descriptive material, the applied prior art satisfies the claim. The prior art

stores data and is fully capable of storing the claimed type of data, this is the extend to

which weight will be given to the claimed data. When descriptive material is not

functionally related to the article, the descriptive material will not distinguish the

invention from the prior art in terms of patentability, *In re Gulack*, 217 USPQ 401 (CAFC

1983).

1stUP teaches computer readable medium having stored thereon a data

structure.

a first data field containing core data such that, when executed by a computer,

the computer performing one or more functions [page 11]; and

a second data field containing branding data for modifying the performance of the

functions such that the performance of the functions evokes an association with a

merchant [page 11].

Regarding claim 27, as responded to earlier in response to claim 26, 1stUP

teaches second data field contains one or more types of data selected from the group

consisting of:

appearance branding data for modifying an appearance of the performance of

the functions (button) [page 11];

operational branding data for modifying the operation of the functions (link to

sponsor site); and

functionality branding data for modifying the performance of the functions

(advertisements) [page 11].

Regarding claim 30, 1stUP teaches method of selling branded software. 1stUP

teaches:

receiving a software application [page 11 – 34];

branding said software application [page 11 – 34];

forwarding said branded software application to a user [page 11 – 34].

Regarding claim 31, 1stUP teaches transmitting said branded software

application to said user over the Internet [page 2].

Regarding claim 33, 1stUP teaches method of selling branded software

comprising the steps of:

receiving a software application with multiple brandings [page 11 - 34];

preventing access to at least one of the multiple brandings associated with said

software application (customized solution) [page 11 - 34];

forwarding said branded software application to a user [page 2].

Regarding claim 34, 1stUP teaches transmitting said branded software application to said user over the Internet [page 2].

Regarding claim 36, 1stUP teaches method of selling branded software. 1stUP teaches:

receiving a software application [page 11 – 34];

adding multiple brandings to said software application (customization, [page 11 – 24];

forwarding said branded software application to a user [page 2].

Regarding claim 37, 1stUP teaches transmitting said branded software application to said user over the Internet [page 2].

Regarding claim 39, 1stUP teaches method of branding software. 1stUP teaches:

receiving a software application [page 11 – 34];

adding at least one branding to said software application (customization) [page

11 – 34].

Regarding claim 43, 1stUP teaches system for branding software. 1stUP

teaches:

an input [page 11];

a processor [page 11]; and

an output [page 11];

wherein branding information is received from said input and wherein said

processor combines said branding information with a software application and forwards

said branded application to said output (available for download) [page 2].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

Claims 3, 24, 25, 28, 29, 32, 35, 38, 40 – 42 and 44 – 46 are rejected under 35

U.S.C. 103(a) as being unpatentable over 1stUP.com hereinafter known as 1stUP.

Regarding claim 3, 1stUP does not specifically teach publisher provides the core

portion to the first merchant with both the first-merchant specific portion and the second-

merchant specific portion (receives sample code to tailor it to meet business

requirements, add logo, change business address etc.), and the first merchant enables

or deletes at least a part of the second-merchant specific portion to produce the first

variation (tailors the code to meet business requirements, e.g. add business logo,

change address, phone numbers, product information). Official notice it taken that it

would have been obvious to one of ordinary skill in the art at the time the invention was

made that businesses modify existing code to their requirements to reuse the code

readily available. For example, contents of a web page.

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to modify 1stUP and allow sponsors to make modification

to existing software to reuse the software for plurality of clients.

Regarding claim 24, 1stUP does not specifically teach first-merchant specific

portion is integrated with the core portion such that the first-merchant specific portion

cannot be replaced by a portion specific to another merchant without damaging the first

variation. However, as responded to earlier in response to claim 3, it would have been

obvious to one of ordinary skill in the art at the time the invention was made that when a

code is modified, original version is damaged.

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made such that the first-merchant specific portion cannot be

replaced by a portion specific to another merchant without damaging the first variation

to be able to make modifications and save the changes made to the original version.

Regarding claim 25, 1stUP does not specifically teach first-merchant specific

portion is integrated with the core portion such that the first-merchant specific portion

cannot be deleted from the first variation without damaging the first variation. However,

as responded to earlier in response to claims 3 and 24, it would have been obvious to

one of ordinary skill in the art at the time the invention was made that when a code is

modified, original version is damaged.

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made such that first-merchant specific portion is integrated with

the core portion such that the first-merchant specific portion cannot be deleted from the

first variation without damaging the first variation to be able to make modifications and

save the changes made to the original version.

Regarding claim 28, 1stUP does not specifically teach second data field contains

branding information for a plurality of merchants, such that all of the branding

information except for branding information relating to a single merchant must be

deleted or deactivated before a computer may properly perform the one or more

functions. However, as responded to earlier in response to claims 3 24, and 25, it would

have been obvious to one of ordinary skill in the art at the time the invention was made

that when a code is modified, original version is damaged.

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made such that second data field contains branding information

for a plurality of merchants, such that all of the branding information except for branding

information relating to a single merchant must be deleted or deactivated before a

computer may properly perform the one or more functions variation to be able to make

modifications and save the changes made to the original version.

Regarding claim 29, as responded to earlier in response to claims 26 – 29, 1stUP

teaches:

appearance branding data for modifying an appearance of the performance of

the functions;

operational branding data for modifying the operation of the functions; and

functionality branding data for modifying the performance of the functions.

Regarding claims 32, 35 and 38, 1stUP does not specifically teach selling said

branded software in a store. However, 1stUP teaches distributing software free of

charge to end users, and charging fee to sponsors for providing customized solution [page 2 – 34].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to sell branded software in store to generate revenue to market product at point of sales. For example, Kmart providing access to their "www.bluelight.com" (commercially available at the time of invention) in stores selling of $0.00 (free of charge).

Regarding claims 40 – 42, 1stUP does not specifically teach where the adding step (customization) occurs. Official notice it taken that it would have been obvious to one of ordinary skill in the art at the time the invention was made that it is a business choice to decide how to customize the application to meet client's business requirements. A business may elect to make change at the software application provider (hardcode the customization) to generate service revenue, make change at the merchant (allow merchant to hardcode the customization) to minimize support expenses, make change at the location of end user (dynamic customization) to control the customization for paying sponsors only.

Regarding claims 44 – 46, 1stUP does not specifically teach who the processor is associated with. Official notice it taken that it would have been obvious to one of ordinary skill in the art at the time the invention was made that it is a business choice to decide how who will customize the application to meet client's business requirements

and associate the processor with that customizing entity. A business may elect to

associate the processor with software application provider (hardcode the customization)

to generate service revenue, a merchant (allow merchant to hardcode the

customization) to minimize support expenses, or, an end user (dynamic customization)

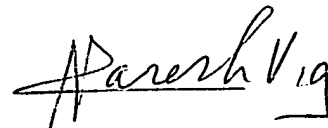to control the customization for paying sponsors only.

Conclusion

The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure. Applicant is required under 37 CRF '1.111 (c) to consider the

references fully when responding to this office action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Naresh Vig whose telephone number is 703.305.3372.

The examiner can normally be reached on M-F 7:30 - 5:00 (Alt Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John Weiss can be reached on 703.308.2702. The fax phone number for

the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Naresh Vig
Patent Examiner
March 5, 2005